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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,310	08/20/2001	Stephen J. Orr	ATI.0100730	7055

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EXAMINER

HSIA, SHERRIE Y

ART UNIT PAPER NUMBER

2614

DATE MAILED: 10/06/2004

Handwritten number 3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,310

Applicant(s)

ORR, STEPHEN J.

Examiner

Sherrie Hsia

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 44-65 is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 15, 18, 20, 21, 23-31, 33-38, 42, 66-78, 80, 81, 84, 86 and 87 is/are rejected.
- 7) ☒ Claim(s) 13, 16, 17, 19, 22, 32, 39-41, 43, 79, 82, 83, 85 and 88 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15, 36 and 81 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. “identifying a third text portion having the first text format, ... comparing the third text portion to the first text portion to detect a substantial match, and excluding the third text portion from being provided to the application ... detected” claimed in claims 15, 36 and 81 is not described in the specification. The specification only states that “rate modulator 250 compares the output of line convertor 240 associated with a decoded page for an exact or substantial match in the FIFO buffer of rate modulator 250”. There is no description for identifying the third text portion and comparing the third text portion to the first text portion and excluding the third text portion as claimed in the claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-10, 14, 18, 20, 21, 23-29, 33-35, 37, 38, 42, 66-76, 80, 84, 86 and 87 are rejected under 35 U.S.C. 102(a) as being anticipated by JP2001008161.

As to claims 1, 23 and 66, JP2001008161 discloses the claimed subject matter, the claimed step of identifying a first text portion having a first format is met by the decoder 20 (Fig. 1 and abstract) and the claimed step of converting the first text portion having the first format to a second text portion having a second format different from the first format is met by the data conversion unit 21 (Fig. 1 and abstract).

As to claims 2, 3, 24, 67 and 68, the claimed limitations are disclosed by JP 2001008161 (Abstract).

As to claims 4 and 69, the claimed limitation is disclosed by JP 2001008161 (paragraph 0017 of the translation of JP2001008161).

As to claims 5, 34 and 70, the claimed limitations are inherently disclosed by JP 2001008161 (paragraph 0013 of the translation).

As to claims 6-9, 25-29, 33 and 71-75, the claimed page identifier is met by the system controller 9 (Fig. 1 and paragraph 0012 of the translation).

Art Unit: 2614

As to claims 10 and 76, the claimed limitation is disclosed by JP2001008161 (Fig. 1 and abstract and translation).

As to claims 14, 35 and 80, the claimed limitation is disclosed by JP 2001008161 (abstract and translation and Fig. 1).

As to claims 18, 42 and 84, the claimed limitation is disclosed by JP2001008161 (abstract and translation).

As to claims 20, 21, 37, 38, 86 and 87, the claimed rate is disclosed by JP 2001008161 (paragraphs 0013 and 0016 of the translation).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 12, 30, 31, 77 and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001008161.

As to claims 11, 12, 30, 31, 77 and 78, JP does not specify the numbers (40) and (32) of characters per display line formats for the first and second character display formats. The examiner takes Official Notice that the teletext format with 40 characters per display line and the closed captioning format with 32 characters per display line is well known and widely used in the art to display the characters, and therefore it would have been obvious to one of ordinary skill in the art to modify JP 2001008161 by including the teletext format with 40 characters per

Art Unit: 2614

display line and the closed captioning format with 32 characters per display line in the conversion and caption display system of JP 2001008161 to display the characters in the screen.

Allowable Subject Matter

5. Claims 13, 16, 17, 19, 22, 32, 39-41, 43, 79, 82, 83, 85 and 88 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 15, 36 and 81 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

7. Claims 44-65 appear allowable over prior art.

The prior art fails to show or fairly suggest a system having the combination as claimed, including a filter to identify a first portion of a text portion embedded in a video stream, the text portion having a first character display format, **a line parser to parse one or more characters from the first portion to generate a character stream and a line converter to convert the character stream to a second portion having a second character display format**, as recited in claim 44.

Art Unit: 2614

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lee shows a caption display controlling device for selectively scrolling and displaying a caption for several scenes.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherrie Hsia whose telephone number is (703) 305-4738.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703) 305-4795.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9306

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Application/Control Number: 09/933,310

Page 7

Art Unit: 2614

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service Office whose telephone number is (703) 308-HELP.



Sherrie Hsia
Primary Examiner
Art Unit 2614

SH

October 1, 2004